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APR - 2 2004

Paper No. 17

In re Application of
David H. Gracias *et al*
Application No. 09/909,420
Filed: July 19, 2001
Attorney Docket No. H0498.70151US00

DECISION ON PETITION

This is a decision on the petition filed on October 29, 2003 by which petitioners request that the final Office action mailed on September 29, 2003 be vacated, and that the amendment filed on October 21, 2003 be entered into the record. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. A refund of the \$130.00 petition fee tendered with the petition will be credit to Deposit Account No. 23-2825.

The petition is granted

A review of the record shows that on May 29, 2003, the examiner mailed an Office action in which the claims were treated on their merits. That Office action set a three month shortened statutory period for response. Within the Office action, the examiner set a two month shortened statutory period for response with respect to certain drawing objections. This was improper; an Office action cannot set two shortened statutory periods running for different lengths of time.

The record further shows that petitioners filed a reply to the May 29, 2003. The reply was filed on July 31, 2003 with a 37 CFR 1.8(a) certificate of mailing dated July 29, 2003. The reply was styled as "Partial Response to Office Action", and explained that it was a reply only to that portion of the outstanding Office action that had required a reply to be filed within two months. This reply was an attempt to comply with the examiner's erroneous setting of two running shortened statutory periods. The reply should have been treated as informal/nonresponsive, and should further have been held to be other than a *bona fide* attempt to reply to the outstanding Office action, because, on its face, it did not reply to all matters raised in the outstanding Office action. See 37 CFR 1.111 and 37 CFR 1.135(c), as well as MPEP § 710.01. The result would have been a letter informing petitioners of the informality, and indicating that the period for filing a complete response to the May 29, 2003 Office action continued to run as set therein, that is, three months from the date of the Office action.

The record additionally shows that the examiner accepted the July 32, 2003 response, and simply repeated the substance of the May 29, 2003 action, and made that action final. Thereafter, when petitioners filed an amendment and an extension of time on October 31, 2003 (with a 37 CFR 1.8(a) certificate of mail dated October 29, 2003), the examiner treated the response as a reply to a final rejection and refused to enter it.

It is clear that the examiner's actions in promulgating an Office action with two running shortened statutory periods was an error, as was the acceptance of an obviously incomplete reply to the Office letter. Petitioners were fully entitled to enjoy the full shortened statutory period of three months, plus any extensions of time to the full statutory limit of six months in accordance with 35 USC § 133 to reply to the May 29, 2003 Office action. In fact, accepting the examiner's erroneous action in setting both a two month and a three month shortened statutory period, petitioners were entitled to extend the two month period to the statutory myxoma. The examiner should note that this is the meaning of the language appearing in the penultimate sentence of paragraph 5 of paper No. 7.

In order to correct these errors, the final rejection dated May 29, 2003 is hereby vacated, as is the advisory action dated November 13, 2003. The amendment filed on October 31, 2003 will be entered as a matter of right pursuant to 37 CFR 1.111.

This application is being forwarded to the Head Supervisory Applications Examiner to refund the \$130.00 petition fee by crediting \$130.00 to Deposit Account No. 23-2825 and to have the amendment dated October 31, 2003 entered. Thereafter, the application will be forwarded to the Supervisory Patent Examiner in Art Unit 3729 who will ensure that the examiner takes action not inconsistent with this Decision.

PETITION GRANTED.



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